



**UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office**

Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
-----------------	-------------	----------------------	---------------------

08/935,717 09/23/97 CATT

M 241939

EXAMINER

HM12/1011

CUSHMAN DARBY & CUSHMAN
INTELLECTUAL PROPERTY GROUP OF PILLSBURY
1100 NEW YORK AVENUE N W
NINTH FLOOR EAST TOWER
WASHINGTON DC 20005-3918

PORTNER, V

ART UNIT

PAPER NUMBER

1645

DATE MAILED:

10/11/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/935,717

Applicant(s)

Catt et al

Examiner
Portner

Group Art Unit
1645



☒ Responsive to communication(s) filed on Jul 20, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1 and 5-10 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1 and 5-10 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

DETAILED ACTION

Claims 1, 5-10 are pending.

Claim 1 has been amended.

Rejections Maintained

1. Claims 1, 5-10 remain rejected under 35 U.S.C. 102(b) as being anticipated or in the alternative under 35 U.S.C. 103 as obvious over Catt et al WO 95/13531 for reasons of record.
2. Claims 1, 5-10 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Jina et al (US Pat. 5,526,120, filing date September 8, 1994) for reasons of record.

Continued Prosecution Application

3. The request filed on January 7, 2000 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 08/935,717 was acceptable and a CPA has been established. An non-final action was made of record previously in paper number 8.

Information Disclosure Statement

4. The information disclosure statement filed July 20, 2000 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each U.S. and foreign patent; each publication or that portion which caused it to be listed; and all other information or that portion which caused it to be

listed. It has been placed in the application file, but the information referred to therein has not been considered.

a. The Application referred to in the Information Disclosure Statement is not the parent application for the instant Application, nor is it in the lineage of this invention. The references filed in 08/772,522 can not be removed from the record as they have been officially been filed in that application.

b. The references listed on the IDS of July 20, 2000 are not of record in the instant Application as no copy has been provided for consideration.

Response to Arguments

5. Applicant argues the rejection of Claims 1, 5-10 under 35 U.S.C. 102(b) as being anticipated or in the alternative under 35 U.S.C. 103 as obvious over Catt et al WO 95/13531 by asserting:

a. that the reading can only be initiated by the correct receipt of the assay device causing the contact portion of the casing to contact the displaceable switch actuating means in the lock and key engagement

b. That the present invention is not anticipated by or rendered obvious by Catt.

6. Applicant's arguments filed with respect to Catt have been fully considered but they are not persuasive because:

a. The relationship of the test strip and the reading device is one in which the spacial relationship is interlocking to insure that a predetermined spacial relationship relative to said reading means is maintained. When the device is received into the reading device the receiving means includes an actuating means which is triggered (claim 13) by the receipt of the device and the actuating means causing the reading of the detection zone to be initiated.

b. The switch actuating means is taught to comprise a fixed projecting portion and a displaceable projecting portion. The casing also comprises a recessed contact portion to accommodate the fixed projecting portion of the switch actuating means.

c. Thus the reading is enabled only by contact and displacement action of test strip with the reading device. All of the limitations argued are not commensurate in scope with the claim Amendment submitted July 20, 2000. The asserted structural and functional novelty of enabling reading of the test strip after contact and displacement is accomplished by the device of Catt. Therefore the reference Inherently anticipates, or in the alternative obviates the now claimed invention for reasons of record in paper number 8.

7. Applicant argues the rejection of claims 1, 5-10 under 35 U.S.C. 103(a) as being unpatentable over Jina et al (US Pat. 5,526,120, filing date September 8, 1994) by asserting:

a. Jina absolutely fails to disclose or suggest the mechanical interaction specifically defined by Applicants claims.

b. That is no requirement for displacement of the interacting displaceable portion of the switch actuating mean be required to initiate reading.

8. Applicant's arguments filed with respect to Jina have been fully considered but they are not persuasive because:

a. Jina et al show a test strip with an asymmetrical end which insures the correct insertion for measuring for an analyte in a liquid sample. The test strip when fully inserted closes an electrical circuit, the closing of which is monitored by the apparatus and allows the determination of an analyte (see col. 4, lines 47-67 and col. 5, lines 1-48; abstract and figures).

b. Thus the reading is enabled only by contact and displacement action of test strip with the reading device. The asserted structural and functional novelty of enabling reading of the test strip after contact and displacement is accomplished by the device of Jina. Therefore the reference obviates the now claimed invention for reasons of record in paper number 8.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ginny Portner whose telephone number is (703)308-7543. The examiner can normally be reached on Monday through Friday from 7:30 AM to 5:00 PM except for the first Friday of each two week period.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynette Smith, can be reached on (703) 308-3909. The fax phone number for this group is (703) 308-4242.

Art Unit: 1645

The Group and/or Art Unit location of your application in the PTO will be Group Art Unit 1645. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to this

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Vgp

September 4, 2000


JENNIFER GRASER
PATENT EXAMINER